



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/540,786

09/21/2005

Andreas Melzer

8324-2

2087

30565

7590

04/24/2009

WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP  
111 MONUMENT CIRCLE, SUITE 3700  
INDIANAPOLIS, IN 46204-5137

EXAMINER

BACHMAN, LINDSEY MICHELE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

04/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/540,786	<b>Applicant(s)</b> MELZER ET AL.	
	<b>Examiner</b> LINDSEY BACHMAN	<b>Art Unit</b> 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 74-101 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 74-101 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 January 2009 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 74-98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In Claim 74, Applicant claims that the first and second ends are the only conductive material adjacent to the dielectric. This limitation is not disclosed in the specification.

Claims 80-82 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

Art Unit: 3734

was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Dependent claims 80-82 recite a plurality of conductor loop windings. This recitation appears to contradict the recitation of independent claim 74 which states that the first and second ends of the conductor are the only conductive material adjacent to the non-conductive dielectric. It is not clear to the Examiner how the ends of the first conductor loop can be the only conductors attached to the dielectric if there are several conductor loops present.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 74, 78-82, 87, 93, 94, 96-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wensel et al. (US Patent Application 2001/0031980) in view of Melzer et al. (US Patent 6,847,837).**

Claim 74, 78-82, 87, 93, 94, 96, 97, 98, 99, 100, 101: Wensel'980 teaches a filter (Figure 8) that is made of a conductor (nitinol) having a first end (44) and a second end (46) in which the entire length of the conductor is bent into a shape that provides mechanical filter (see Figure 8). The first and second ends are connected to a non-conductive dielectric (16; hard plastic described in paragraph [0047]).

Wensel'980 does not teach that the capacitance and inductance of the filter are chosen to have a resonance frequency turned to the frequency of an MRI tomograph.

Art Unit: 3734

Melzer'837 teaches a vessel filter that has a resonance circuit that corresponds to the frequency of an external magnetic field (column 3, lines 50-60) because this allows clear, signal intensive imaging of the filter (column 3, lines 21-29) and it allows the surgeon to measure flow through the filter (column 4, lines 11-17). Further, the filter taught by Melzer'837 has a basic framework that is formed by the vessel filter (see Figures 8a, 8b) and also forms an inductance (elements 25a, 25b in Figures 8a, 8b) because this is the simplest design. It would have been obvious to one skilled in the art at the time the invention was made to modify the device taught by Wensel'980 to have a resonance circuit that corresponds to the frequency of an external magnetic field as taught by Melzer'837 in order to clearly see the filter and also measure blood flow through the filter.

**Claims 75-77 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wensel'980 in view of Melzer'837, as applied to claim 74 above, and further in view of Dubrul et al. (US Patent 6,238,412).**

Wensel'98 in view of Melzer'837 teaches the limitations except for a non-conductive coating over the filter.

Dubrul teaches a similar device that contains a polymer coating over the filter structure (column 6, lines 37-49). All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**Claim 83-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wensel'980 in view of Melzer'837, as applied to Claim 74, in further view of Petruzzi (US Patent 4,655,219).**

Wensel'980 in view of Melzer'837 teaches the limitations of Claims 83-85 except for an extension that will aid in attaching the conductor loop to the vessel wall.

Petruzzi teaches that it is old and well known to provide a similar device with extensions (distal tip of element 42) because this will aid in attaching the body (Figures 6-9). It would have been obvious to one of ordinary skill in the art to modify the device taught by Wensel'980 in view of Melzer'837 with the extensions taught by Petruzzi so that it too has this advantage.

**Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wensel'980 in view of Melzer'837, as applied to Claim 80, in further view of Bates et al. (US Patent 6,224,612).**

Wensel'980 in view of Melzer'837 teach the limitations of Claim 86 except for a device with a double filter.

Bates'612 teaches a similar device with a double filter (Figure 3a). The claim would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

**Claim 88-92 and 95 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wensel'980 in view of Melzer'837, as applied to Claim 80, in further view of Gordon (US Patent 5,938,645).**

Art Unit: 3734

Wensel'980 in view of Melzer'837 teach the limitations of Claim 88, 89, 90, 91, 92 and 95 except for a brace connected to the conductor loops.

Gordon'645 teaches that it is old and well known to provide a brace (110) for the purpose of capturing thrombi in the vessel. It would have been obvious to one of ordinary skill in the art to modify the device taught by Wensel'980 in view of Melzer'837, with the brace taught by Gordon'645 so that it too has this advantage.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3734

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./

Examiner, Art Unit 3734

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734